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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,238	12/28/2001	Shinichi Hirata	217537US-6 DIV	6314
22850	7590	05/15/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
BROWN, RUEBEN M				
ART UNIT		PAPER NUMBER		
2623				
NOTIFICATION DATE		DELIVERY MODE		
05/15/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/029,238

**Applicant(s)**

HIRATA, SHINICHI

**Examiner**

REUBEN M. BROWN

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/19/08 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 3/19/2008 have been fully considered but they are moot in view of the new grounds of rejection. Applicant amends claim 17 to recites, '*a reception device for controlling a recording module at a same location as said recording module, comprising...*'; whereas claims 22, 23, 29, 3035 & 40, likewise recite similar subject matter.

Applicant argues that Blake does not provide the additionally claimed '*device for controlling a recording at a same location*'. Applicant argues on page12 that central processing system, 334 is remote from the recording system in Blake. First of all, Blake makes it clear that

recording device 336 in at least one embodiment is a recording device at a user's home; see Para [0089]. It is quite clear from the discussion in Blake of Para [0089-0093], that the central processing system may include devices that are at least partially located at the user's home, as well as at least partially located remote from the user. However, the reference does not provide a definitive explanation of the location of the central processing system 334.

Lawler is provided to teach that the recording location may be a VCR or any other recording device that located at the headend/server. One of ordinary skill in the art at the time the invention was made, would have readily recognized the benefit of recording at the remote server, at least for the advantage of having a more storage capacity at the server.

Thus, the combination of Blake & Lawler reads on the claimed.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blake, (US PG-PUB 2003/0031465), in view of Lawler, (U.S. Pat # 5,585,838).

Considering claims 17 & 23, the claimed reception device for controlling a recording module, comprising:

*'means for receiving a formatted file through the network'* reads on the personal computer, PCTV or set top box, Para [0027] & [0031] & [0089].

*'means for extracting at least one text-based control command in said formatted file received by the means for receiving, wherein the text-based control command is in the formatted file to control the recording module'*, reads on the disclosure in Blake that the user may send recording requests via an e-mail account via the processing system 334. The processing system 334 communicates the requests to the user's recoding device 336.

*'means for controlling the recording module based on the text based control command extracted by the means for extracting, such that the means for controlling has a timer reservation function and the means for controlling reserves an operation time of the recording module'* reads on the disclosure of Blake, which teaches that control codes maybe transmitted through a telecommunications network to activate and control a VCR a subscriber's residence to record a

program specifically requested by the user. Blake also teaches that the user may send an e-mail message to processing system 334, [0089]-[0093].

As for the claimed '*timer reservation function*', this feature is inherently included in Blake since the system starts the playback & recording of a particularly requested movie/program at the appropriate time. Such a step requires a timing mechanism that determines the appropriate date/time in order to turn on & tune a receiving/recording device to the appropriate channel.

As for the additionally recited feature of the reception device for controlling a recording module at a same location, as pointed above Blake does not explicitly disclose the location of the central processing system 334. Nevertheless, Lawler which is in the same field of endeavor of recording programming that can be distributed from a server, teaches that when a user makes a request using a Record button, that the recording may take place at a VCR local to the user or at the remote server, see Fig. 7; col. 13, lines 61-67 thru col. 14, lines 1-15. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Blake to allow recording at the head end, as taught by Lawler, at least for the desirable advantage of generally more storage capacity being available at the headend than at the user's location.

Considering claims 18, 24, 31, 36, 41 & 48, Blake teaches that a PC, PCTV, laptop, STB or any other device capable of transmitting data from a remote location, including by use of a

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modem, [0089] and that the devices may operate using a web browser, which reads interprets data transmitted over the Internet, [0027], [0041] & [0093].

Considering claims 19, 25, 32, 37, 42, & 49, Blake discloses that the processing system 334 stores the recording information, [0089], whereas in at least one embodiment of Lawler the time information would necessarily be stored at the headend.

Considering claims 20-21, 26-27, 33-34, 38-39, 43-44 & 50-51, the claimed TV recording module, reads on the VCR unit at the headend of Lawler, col. 14, lines 1-15.

Considering claims 22, 29 & 46, the claimed subject matter reads on Blake Para, [0034] & [0079].

Considering claims 28 & 45, Blake discusses that the receiver may include a modem, [0026], [0030].

Considering claims 30, 35, 40, 45 & 47, the claimed transmission/reception device comprising elements that corresponds with subject matter mentioned above in the rejection of claims 17 & 23 is likewise treated. As for the claimed '*transmitter*' or '*means for transmitting*', reads on the remote location used by a subscriber to schedule recordings on their home VCR, Blake [0089]. As for the additional limitation of claim 40 that the second location is different from the a first location which sent the text-based control command, the subject matter is met by

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the above discussion that in Blake and Lawler a user at home or at remote location send a request to Record a program. Subsequently the program is recorded at the headend, as taught Lawler.



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**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
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**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**

(571) 273-7290 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/  
Patent Examiner, Art Unit 2623